REMARKS

Claims 9-11, 13-20, 22, 23, 45, and 46 were pending. Claims 1-8, 12, 21, and 24-44 were previously canceled. In this Reply, claim 9 has been amended to specify that certain features are performed "by a computer." Support for amended claim 9 can be found in the specification as filed in at least FIG. 1 and its accompanying detailed description. After entry of the amendment, claims 9-11, 13-20, 22, 23, 45, and 46 continue to be pending in the present application.

Applicant submits that claims 9-11, 13-20, 22, 23, 45, and 46 are allowable, as discussed below.

Summary of the Office Action

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 101 as being directed to non-statutory subject matter.

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 5,214,579, to Wolfberg et al. (hereinafter "Wolfberg"), in view of U.S. Patent No. 5,884,287, to Edesess (hereinafter "Edesess"), and further in view of Official Notice.

Claims 19-20 were rejected under 35 U.S.C § 103(a) as being unpatentable over Wolfberg in view of Edesess, and further in view of Lane reference (hereinafter "Lane").

35 U.S.C § 112, second paragraph

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner states that it is not clear how the features in independent claim 9 are related. Consequently, based their dependency on claim 9, dependent claims 10-11, 13-20, 22, 23, 45, and 46 are also unclear.

The subject matter claimed in claim 9 is described in applicant's specification in at least page 18, line 26 – page 22, line 9, which describes the "method for determining the projected accumulation amount using Select Funds." (See specification as filed, page 18, lines 26-27.)

Applicant's technology describes four projection methods. Claim 9 relates to projection method two, which is described in applicant's specification in at least page 20, line 20 – page 22, line 8. Various parameters used by the projection methods are stored in a projection method parameters file. (See specification as filed, page 19, lines 4-13.)

Applicant believes that independent claim 9 is clear. If the Examiner still believes that claim 9 is unclear after considering page 18, line 26 – page 22, line 9 of applicant's specification, applicant respectfully requests that the Examiner telephone the undersigned regarding potential amendments that would satisfy the Examiner's concerns.

35 U.S.C. § 101

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 101 as being directed to non-statutory subject matter. Applicant has amended independent claim 9 to recite "by a computer" in various method steps. Amended claim 9 is tied to the other statutory class of machine (that is, a computer). Dependent claims 8-11, 13-20, 22, 23, 45, and 46 depend upon independent claim 9 and incorporate the features of claim 9. Accordingly, applicant submits that method claims 9-11, 13-20, 22, 23, 45, and 46 are directed to statutory subject matter. Withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103(a)

Independent claim 9 is directed to a computer implemented method for projecting an accumulated investment amount for a portfolio having a plurality of funds. In the Office Action, claim 9 was rejected under 35 U.S.C § 103(a) as being unpatentable over Wolfberg in view of Edesess, and further in view of Official Notice. As discussed below, applicant submits that Wolfberg and Edesess fails to show or suggest various features of applicant's independent claim 9, and additionally, applicant traverses the Examiner's assertion of official notice.

First, independent claim 9 recites, among other things, "completing a projection method parameters file in which various parameters are identified, including a standard deviation of return for the plurality of funds, an average yield for the plurality of funds, and a probability that the average yield for the plurality of funds will exceed a projected yield in any year." The Examiner recognized that Wolfberg fails to show or suggest this feature in applicant's claim 9. (See Office Action, bottom of page 3 – top of page 4). The Examiner attempts to make up for

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this deficiency in Wolfberg by referring to Edesess, but applicant submits that Edesess does not show or suggest this feature either. Specifically, the Examiner contends that Edesess discloses applicant's feature in claim 9 of "an average yield for the plurality of funds, and a probability that the average yield for the plurality of funds will exceed a projected yield in any year." However, a quick word search of Edesess shows that Edesess does not contain "average yield" or "projected yield." If the Examiner continues to believe that Edesess discloses these features, applicant respectfully requests that the Examiner quote the specific words relied on in Edesess, so that applicant can consider the specific words being interpreted by the Examiner to show these features.

Second, applicant's claim 9 recites, among other things, "generating a projection random number starting point for an initial year in the preselected time period" and "generating a random number starting point for a subsequent year in the preselected time period based upon the random number starting point for the initial year." The Examiner took official notice that "generating a projection random number starting point and generating another random number starting point based upon the random number starting point is old and well known in the art of simulation/modeling." (See Office Action, middle of page 8). Applicant respectfully traverses the Examiner's assertion of official notice for the reasons below.

As the Examiner knows, the standards for taking official notice are covered in MPEP § 2144.03. As MPEP § 2144.03(A) explains, "[it] would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." (emphasis added). In the Office Action, the Examiner makes an assertion of common knowledge in the art without citing any prior art reference to support the assertion. (See Office Action, middle of page 8). Applicants submit that the Examiner's assertion of common knowledge without documentary evidence is inappropriate because it is not capable of instant and unquestionable demonstration that applicants' features of "generating a projection random number starting point for an initial year in the preselected time period" and "generating a random number starting point for a subsequent year in the preselected time period based upon the random number starting point for the initial year" are old in the art. Specifically, applicant's features are not directed to using random numbers in general. Rather, applicant's features use random numbers in a specific way in relation to each year in a preselected time period.

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Applicant submits that applicant's specific use of random numbers in relation to each year in a preselected time period is not capable of instant and unquestionable demonstration as being old and well known in the art.

Additionally, MPEP § 2144.03(A) also explains that "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." Applicant also submits that the Examiner's assertion of common knowledge without documentary evidence is inappropriate because computer simulation/modeling is an area of esoteric technology in which "assertions of technical facts . . . must always be supported by citation to some reference work recognized as standard in the pertinent art." (MPEP § 2144.03(A)).

Lastly, applicant submits that applicant's features are not old and well known in the art because, outside of applicant's own specification, applicant is not aware of other publications that pre-date applicant's technology and describe these features.

For all the foregoing reasons, applicant traverses the Examiner's assertion of common knowledge in the art. If the Examiner continues to assert common knowledge in the art, "the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. . . . If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." (MPEP § 2144.03(C)).

For the foregoing reasons, applicant submits that independent claim 9 is patentable over Wolfberg and Edesess, and that the Examiner's assertion of official notice has been traversed. Accordingly, applicant submits that independent claim 9 is allowable. Claims 10-11, 13-20, 22, 23, 45, and 46 depend upon independent claim 9, and the rejections of the dependent claims are traversed because "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." (MPEP § 2143.03). Applicant's silence with respect to the particular rejections of the dependent claims should not be construed as a concession that the features of such claims are shown in the cited references. Rather, applicant's silence is based on the belief that the foregoing adequately traverses the rejections of the dependent claims. Applicant hereby reserves the right to address and traverse the specific rejections of any of the dependent claims in the future.

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Conclusion

In view of the foregoing, applicant submits that claims 10-11, 13-20, 22, 23, 45, and 46 are allowable. Accordingly, reconsideration and allowance of the application are respectfully requested.

No fees are believed to be due in connection with this paper. However, if any fees are due, please charge any fees due in connection with this Reply to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

Date: May 26, 2009
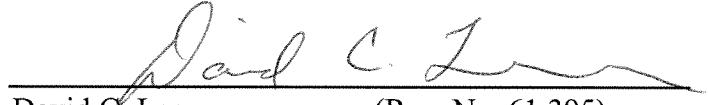
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